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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,093	02/25/2004	Xavier Blin	05725.1263-00	8509

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EXAMINER
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RAE, CHARLESWORTH E

ART UNIT	PAPER NUMBER
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1614

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/785,093	Applicant(s) BLIN ET AL.	
	Examiner Charleswort Rae	Art Unit 1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to:
- 8) ☒ Claim(s) 1-114 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

Claims 1-114 are currently pending in this application and are the subject of this Office action.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-107, and 114, drawn to a composition comprising a) at least one liquid fatty phase, b) a dispersion of at least one polymer particle dispersed in the liquid fatty phase, and c) at least one compound chosen from aliphatic/aromatic polycarboxylic acids and alcohols, classified in class 528, subclass 176. If this Group is elected, then the below Summarized Species Election is also required.
- II. Claims 108-110, drawn to a method of cosmetic care or makeup, producing a polyesteramine/polyesteramine composition, classified in class 435, subclass 114. If this Group is elected, then the below Summarized Species Election is also required.
- III. Claims 111 and 112, drawn to a method of making a composition, classified in class 435, subclass 114. If this Group is elected, then the below Summarized Species Election is also required.

- IV. Claim 113, drawn to a makeup product, classified in class 528, subclass 176. If this Group is elected, then the below Summarized Species Election is also required.

Inventions I-IV directed to related product and process for practicing the same product. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, invention I is distinct from invention II as invention II can be practiced by a materially different product e.g. lanolin lip balm, and also distinct from invention IV which is directed to a makeup product; invention III is distinct from invention I as invention III can be used make materially different compositions as evidenced by claim 114. For the above reasons inventions II and III are deemed to be distinct methods of practicing the same product. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Applicant is required to elect a single invention e.g. invention I, for examination purposes.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### Election of Species regarding Groups I-IV

This application contains claims directed to the following patentably distinct hydrous and anhydrous compositional species, which encompass multiple liquid fatty phase species, multiple polymer particles, multiple polycarboxylic acids, multiple alcohols, and multiple optional compounds. Thus, species comprising different, or varying amounts of, polymeric particles, polycarboxylic acids, alcohols, stabilizers, gelling agents etc, would reasonably exhibit different pharmaceutical/personal characteristics. The composition species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required to elect one specific disclosed species from the below list for examination purposes:

1) either a) an anhydrous composition (see claim 75), or 1b) a hydrous composition, and also either c) without a second composition, or d) with a second composition (see claim 114)

2) a single specific composition species wherein each active ingredient is specified e.g. lipstick composition (i.e. Example 2, specification, page 55, paragraph 0275; see also claim 74):

Polyethylene wax	10.0%
Perfomacol 550 alcohol	2.5%
Sucrose acetate isobutyrate	68%
Eastman SAIB	5%
Pigment paste	13.5%
Perfume	0.5%

3) a polycarboxylic acid compound species e.g. butyl benzyl phthalate,

3) an alcohol compound species e.g. methanol

4) a polymer particle e.g. polyurethanes

- 5) a stabilizer e.g. block polymer
- 6) a gelling agent e.g. styrene-ethylene/propylene-styrene copolymer
- 7) a wax e.g. ethylene polymer
- 8) composition product e.g. lipstick

It is noted that if applicant elects a composition comprising a compound of the recited alcohol of formula R1OH of claim 5, or the recited dicarboxylic acid of claim 8, or the recited tricarboxylic acid formula of claim 17, then applicant is further required to elect a specifically defined compound wherein each variable/optional group is provided with respect to R1, n, and R, respectively.

#### **Additional Election of Species regarding Group III**

This application contains claims directed to the following patentably distinct of methods of practicing the hydrous and anhydrous compositional species, which encompass multiple liquid fatty phase species, multiple polymer particles, multiple polycarboxylic acids, multiple alcohols, and multiple optional compounds. Thus, species comprising different, or varying amounts of, polymeric particles, polycarboxylic acids, alcohols, stabilizers, gelling agents etc, would reasonably exhibit different pharmaceutical/personal characteristics. The composition species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required to elect one specific disclosed species from the below list for examination purposes:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 108-114 are generic to the above species.

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There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.**

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

24 June 2007  
CER

BRIAN YONG S. KWON  
PRIMARY EXAMINER

